

Application Serial No. 10/718,290

REMARKS**35 USC 101**

Claims 7-31 are rejected under 35 USC 101 for being directed to non-statutory subject matter. Independent claims 7 and 23 are amended to recite the tangible result of a messaging server receiving a request to un-publish a digital certificate, and in response to that request, un-publishing the digital certificate and notifying concerned parties that the digital certificate is withdrawn from use. The server actively removes the digital certificate from the publication record, and sends a message to various users indicating that this has been done. These are practical, tangible results. Thus, claims 7 and 23 both recite steps that produce a tangible result. Because claims 8-22 and 24-31 depend upon either claims 7 and 23, they also fall within a statutory class.

35 USC 102(b)

Claims 7-9, 12, 15-17, 19, 23-25, 27-29, and 31 are rejected under 35 USC 102(b) for being anticipated by Schoen. Independent claims 7 and 23 are amended to recite the language of dependent claims 10 and 26, respectively. Because claims 10 and 26 are rejected under 35 USC 103(b) for being obvious under Schoen in view of Perlman, and independent claims 7 and 23 now contain the same language, the anticipation rejection is deemed moot.

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35 USC 103

Claims 10-11, 13-14, 18, 26, and 30 are rejected under 35 USC 103 for being obvious under Schoen in view of Perlman. Applicants respectfully traverse.

Amended claim 7 recites a method of managing the exchange of secure online instance messages comprising an associated instant messaging module that submits a certificate publication request to a messaging server, the publication request also specifying a digital certificate corresponding to the subscriber device, the messaging server temporarily storing the submitted digital certificate in a publication record, the messaging server providing logged-in subscriber devices with selected information concerning certificates of other subscriber devices, the messaging server receiving a particular subscriber device's request to un-publish its digital certificate, and responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use. This creates an instant messaging system that allows secure synchronous online messages between subscribers, where digital certificates are used to sign and encrypt the messages. See specification, page 3.

Schoen discloses an instant messaging system with an instant messaging server in operative communication with an instant messaging originator and an instant message recipient. [0033]. The instant messaging policy certificate issuer generates an instant

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messaging public key cryptography policy certificate containing selected instant messaging public key cryptography policy control information. [0074]. The instant messaging PKI policy certificate issuer stores the certificate and a copy in a local database. [0074]. The Examiner concedes that Schoen does not disclose a messaging server receiving a subscriber device's request to un-publish its digital certificate and in response to that request, the messaging server removes the digital certificate from the publication record, identifies other logged-in subscriber devices that previously designate the particular subscriber device for potential future secured instant messaging, and notifies the identified devices of the digital certificate withdrawn from use. However, the Examiner asserts that Perlman discloses these steps.

Perlman discloses a blacklist, which contains an entry for every unexpired certificate that should be considered invalid. Column 6, lines 39-40. The Certification Authority may publish a blacklist, but only periodically or on request. Column 6, lines 38-39. If a user wants to verify the authenticity of another user, he can request a copy of the other user's certificate and a copy of the blacklist to determine if the issue date of the certificate is prior to the blacklist start date and therefore invalid. See column 7, lines 45-58.

Perlman does not teach or suggest receiving a request to un-publish a digital certificate or a process for notifying other devices that the digital certificate was withdrawn.

Publishing a blacklist is different from removing an entry for the digital certificate. In claim 7, a subscriber's device requests that the digital certificate be unpublished. In addition, the process disclosed in Perlman is not automatic. Either a user must request a

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copy of the blacklist or the Certification Authority periodically publishes it. Once the user has a copy of the blacklist, he must personally determine whether the other user's certificate was invalidated. Column 6, lines 43-46. In claim 7, on the other hand, once the subscriber device requests that the digital certificate be unpublished, the messaging server automatically removes the digital certificate from the publication record, identifies other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifies the identified devices that the digital certificate was withdrawn.

Claim 23 was amended to recite similar limitations to claim 7. Thus, claim 23 is patentable for at least the same reasons.

Because claims 8-9, 11-22, 24-25, and 27-31 all depend from claims 7 or 23, they are patentable for at least the same reasons as their respective base claims.

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Conclusion

Applicants respectfully posit that the pending claims have been distinguished from the art of record, and that all rejections of the claims have been overcome. Accordingly, Applicants respectfully request allowance of all claims. The Examiner is invited to please contact Applicants' agent at (650) 474-8400 should any questions arise.

Respectfully submitted,


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